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Rejections Under 35 U.S.C. 102

Claims 10, 11, 14, and 15 are rejected under 35 U.S.C. 102(e) as being unpatentable over United States Patent No. 6,587,680 issued to Ala-Laurila et al. on July 1, 2003. This ground of rejection is respectfully traversed for the following reasons.

In response to the Office Action's general explanations, applicants note that what is required for a valid 102 rejection of a claim is for the prior art reference to teach, explicitly or inherently, all of the limitations of that claim. This means that each of the various limitations that are set forth in the claim—, which are typically defined not only by 1) a recitation of the element that makes up the limitation but also, at least in part, by 2) the inter-relationships between the elements—, must be found in the cited reference. In other words, the elements must be found in the reference, and they must have the same relationship to each other as prescribed in the claim. Furthermore, the elements and their relationships must be set forth in the reference in a manner that gives the public possession of the invention. Disparate, disconnected elements that are similar to limitations recited in a claim are insufficient, as are different elements that appear to have the same relationships, at least in part, as the elements in recited in the claims. While it is true that a reference that expressly discloses a claimed invention and then states that such a thing is a bad idea is an anticipatory reference—because it actually showed the entirety of the claim—, a reference that an Examiner states teaches a claim by virtue of the skill of an artisan or other reasoning from what is expressly set forth in the reference indeed does **not** anticipate the claim when there are actual or implied teachings in the reference that contradict the suggested reasoning of the Examiner. This is because the teaching of the reference is such that it does **not** put the invention in the hands of the public, in that the element is not actually or inherent in the reference but rather excluded therefrom, and the Examiner's reasoning therefore appears to be based **not** on the reference but on hindsight from the applicant's own disclosure.

Turning to the specifics of the instant application, notwithstanding the entirety of the Office Action's rebuttal to applicants' prior arguments, with which applicants are **not** admitting agreement, nevertheless, applicants continue to believe that the Office Action

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has not made a prima facie showing that all of the elements of applicants' independent claim 10 are disclosed by Ala-Laurila et al.

First, the Office Action dated December 13, 2000, in the last paragraph of page 2, states that applicants' limitation, which recites "receiving a response to said request at said wireless terminal, when said second base station knows said first base station prior to receiving said request, said response indicating that said second base station can engage in expedited handoffs with said first base station" is met by column 10, lines 44-49 of Ala-Laurila et al. Applicants note that this section states:

When message 502 is received at old-AP 14, function 503 accepts the message, function 504 operates to retrieve security association parameters SA,SA from its security association (SA) data base, and function 505 operates to send a handover request that contains the parameters SA,SA to new-AP 114.

Clearly, this section does not refer to any function at the mobile terminal, as required by applicants' claim. Rather, this section refers to functions performed at old-AP 14, which is a base station, not a mobile terminal. Furthermore, old-AP 14 does not send anything back to the mobile terminal. Rather, old-AP 14 receives a message and in response simply communicates with new-AP 114. It does not appear to applicants that there is any teaching or suggestion in Ala-Laurila et al. that a response as required by applicants' claim 10 is received at the mobile terminal.

Second, it is clear that in Ala-Laurila et al., at the time of handover, no information about to which base station an expedited handover can be made is transmitted to a mobile terminal.

More specifically, Ala-Laurila et al. states:

Handover availability determiner 36 provides indications to mobile terminal 12 of the available APs to which a handover of communications is possible, this availability being contained in an available access point list 38 that contains the identities of the APs that are available for the handover of communications.

Available access point list 38 can be communicated to the mobile terminals 12 at selected time intervals, or access point list 38 can be provided to each mobile terminal 12 when the mobile terminal is initially activated. ...

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(See Ala-Laurila et al., generally at column 7, lines 56-67, and in particular, lines 62-65 (emphasis added).) Clearly then, in Ala-Laurila et al., no indication as to with which base stations (the APs of Ala-Laurila et al.) the current base station can engage in expedited handovers is provided to the mobile terminal at the time of handoff. Rather, at best, such an indication, which is available access point list 38, is provided to the mobile terminal at a some point in time that is independent of any handover request, i.e., at the preselected time interval or upon mobile terminal activation. Indeed, not only is providing such an indication, i.e., list 38, at the time of handover in response to a request for a handover not specifically taught in Ala-Laurila et al., doing so is impliedly **taught away** from by Ala-Laurila et al., because to provide such a list at the time a handover is requested would increase the time required to complete the handover, and the stated goal of Ala-Laurila et al. is to minimize the time to complete the handover, particularly for VOIP and video distribution. (See Ala-Laurila et al., column 5, lines 19-25 and column 8, lines 1-16.)

Additional support for the proposition that in Ala-Laurila et al., at the time of handover the mobile terminal receives no indication, express or implied, as to the fact that any base station can engage in an expedited handover with any other base station is as follows. In the inventive system of Ala-Laurila et al. there appears to be only one type of handover, so there is never any need to indicate what type of handover can be engaged in. Also, although in Ala-Laurila et al. the request for handover may be initiated by the mobile terminal, the handover process thereafter is driven by the base stations, which have no need to tell the mobile terminal what type of handover can be had, as they coordinate merely amongst themselves. Moreover, at the time of the handover request the mobile station **already knows** with whom the base station can engage in a handover, by virtue of available access point list 38, which was made available to it prior to the handover request and not in response to any handover request; and since the mobile station knows prior to the handover request with whom the base station can engage in a handover, there is no need at the time of handover to transfer, or indicate, express or impliedly, the same information. Indeed, not only would doing so would be redundant, but any express indication would be time consuming and a waste of resources, because of the express knowledge already available at the mobile terminal, i.e., list 38, and there is

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certainly no need for an implied indication to the mobile terminal when there already is express knowledge available at the mobile terminal of whatever is allegedly implied. Furthermore, given the fact that there is only one type of handoff, the request for a handoff by the mobile terminal is a request for an express handover, so there is no need to indicate in a response that such a handover is possible, since being the only type of handover, of course it is possible.

However, as noted above, by contrast, applicants' independent claim 10 requires that an indication that the second base station can engage in expedited handoffs with the first base station be received in the response to the request for handoff. This is because claim 10 requires that the response to the handoff request received by the wireless terminal must indicate that the second base station can engage in expedited handoffs with the first base station when that is indeed possible. Thus, the response itself must include, or imply, an indication that the second base station can engage in expedited handoffs with the first base station. However, as explained hereinabove, in *Ala-Laurila et al.* there is no such indication, express or implied, in any response to the mobile terminal at the time of handover, if there even is a response.

Thus, *Ala-Laurila et al.* does not meet, expressly or impliedly, the terms of applicants' claim language, even broadly construing applicants' claim language. Beyond that, of course, when read in view of the specification, applicants' claim language defines an invention different than what *Ala-Laurila et al.* teaches. Thus, applicants' independent claim 10 is allowable over *Ala-Laurila et al.* under 35 U.S.C. 102.

Rejections Under 35 U.S.C. 103(a)

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Ala-Laurila et al.* in view of United States Patent No. 6,434,134 issued to La Porta et al. on August 12, 2002. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Ala-Laurila et al.* in view of United States Patent No. 5,598,459 issued to Haartsen on January 28, 1997. These grounds of rejection are respectfully traversed for the following reason.

Given that independent claim 10 from which each of these dependent claims respectively depends is allowable over *Ala-Laurila et al.* for the reasons cited

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hereinabove, and neither supplementary reference supplies the element that would enable a proper rejection under 35 U.S.C. 102 of independent claim 10, because it does not supply at least the element indicated hereinabove to be lacking in Ala-Laurila et al., dependent claims 12 and 13 are allowable over the proposed combination under 35 U.S.C. 103(a).

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Conclusion

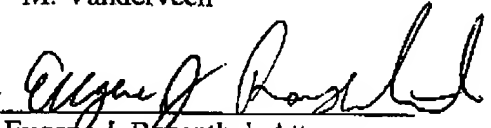
It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, he is invited to call applicant's attorney so that arrangements may be made to discuss and resolve any such issues.

In the event that an extension of time is required for this amendment to be considered timely, and a petition therefor does not otherwise accompany this amendment, any necessary extension of time is hereby petitioned for, and the Commissioner is authorized to charge the appropriate cost of such petition to the **Lucent Technologies**.
Deposit Account No. 12-2325.

Respectfully,

S. Davies
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By 
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Lucent Technologies Inc.

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